UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte JUSSI KUISMA and SISKO PIHLAJAMAKI

_____

Appeal 2008-2927
Application 10/023,447
Technology Center 2400

_____

Decided:[1] March 12, 2009

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Before JOHN C. MARTIN, LEE E. BARRETT, and STEPHEN C. SIU,
Administrative Patent Judges.

MARTIN, *Administrative Patent Judge.*

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a
civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided
date shown on this page of the decision. The time period does not run from
the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-17, which are all of the pending claims, under § 103(a).[2]

We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

A. *Appellants' invention*

Appellants' invention relates to the transfer of multimedia messages in a multimedia messaging system (Specification 1:5-6). The content of a multimedia message may be, for example, a video clip, an audio clip, or a combination of these. *Id.* at 1:11-12.

In the "Background of the Invention" part of the Specification (at 2-3), Appellants describe various problems encountered when using the prior-art multimedia messaging system, including:

> In a normal situation the MMSC [Multimedia Message Service Centre] transmits a notification message to the terminal as soon as a multimedia message addressed to the terminal in question arrives. However, the MMSC may fail to transmit the notification message for several reasons and the terminal may

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[2] The rejection of claims 15-17 under § 101 (Final Action 2) is not repeated in the Answer and is therefore presumed to have been withdrawn as a result of the January 20, 2006, "Response After Final," which amended those claims in response to that ground of rejection and was approved for entry by the Examiner in the February 14, 2006, Advisory Action.

fail to receive it. For example, if the terminal is switched off, it
cannot receive notification messages.

Id. at 1:33 to 2:1.

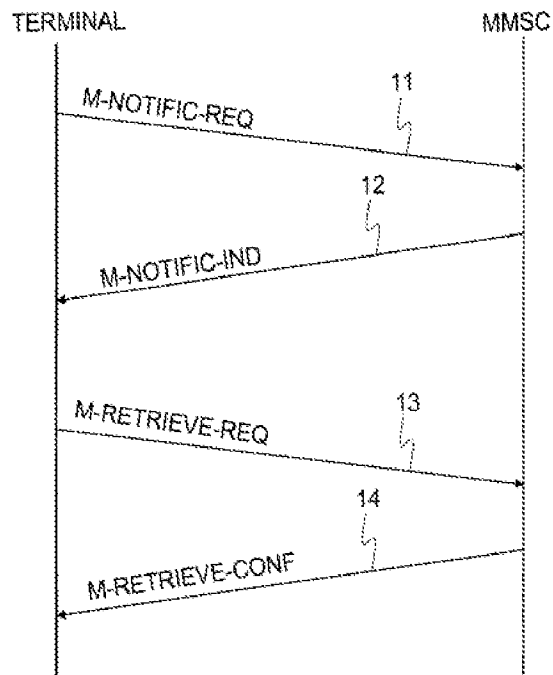Appellants' Figure 1 is reproduced below.

Fig. 1

Figure 1 is a message chart illustrating a method according to a
preferred embodiment of the invention. *Id.* at 7:4-5.

The terminal sends an inquiry message 11 (labeled "M-NOTIFIC-
REQ") to the MMSC, requesting the MMSC to send a notification message
to the terminal identifying any multimedia messages received by MMSC as

to which the terminal has not received a notification message from the MMSC. *Id*. at 7:5-8.

As shown in Figure 3a, inquiry message 11 contains only headers (or header fields) at the multimedia application level. *Id*. at 11:20-22. The header fields shown in Figure 3a are:

> Message type = m-notific-req
> Transaction-ID =
> MMS-Version =
> From_date_and_time =

"When the MMSC receives the message 11 with the message type 'm-notific-req' from the terminal, it knows that the terminal wants it to send notification messages to the terminal." *Id*. at 11:24-27. Upon receiving request 11, "the MMSC determines by software whether it has received multimedia messages addressed to the terminal in question on which the terminal has not received a notification message from the MMSC." *Id*. at 7:36 to 8:3. We understand these two passages to mean that the MMSC interprets the message type "m-notific-req" as a request for notification of such multimedia messages. These multimedia messages include: (1) notification messages the MMSC has sent but the terminal has not received; and (2) notification messages the MMSC has not yet sent. *Id*. at 7:9-12. A notification message that has been sent to a terminal without being acknowledged thereby is treated as not received by the terminal. *Id*. at 8:3-5.

> The header field "From_date_and_time" informs the MMSC
>
> of the moment from which on the terminal wants to receive undelivered notification messages. This information can be defined by the user himself or it can be fetched from the terminal's memory, in which it has been stored in advance. The information may have been stored e.g. in a certain log file when the terminal was used for communication, such as a speech call, for the last time.

Id. at 11:34 to 12:3.

If the MMSC has notification messages for the terminal, these are transmitted in the response message 12. *Id*. at 8:9-11. If the MMSC does not have notification messages for the terminal, information that there are no notification messages is attached to the response message. *Id*. at 8:11-13.

When the terminal receives the response message 12, it can conclude from the information included in the response message 12 what kind of multimedia messages the MMSC has and fetch one or more multimedia messages from the MMSC. *Id* at 8:14-17. The terminal then sends a retrieval message 13 to the MMSC indicating that it wants to fetch a multimedia message. *Id*. at 8:20-21. The MMSC responds by sending the multimedia message to the terminal in message 14. *Id*. at 8:22-23.

B. The claims

The independent claims before us are claims 1, 8, 9, 10, 15, and 17, of which claim 1 reads:

1. A method of transferring a multimedia message in a multimedia messaging system, which comprises a terminal and a multimedia messaging centre, arranged to communicate with each other at least partially wirelessly, the multimedia messaging centre being arranged to receive multimedia messages, addressed to the terminal, and to transmit a notification message to the terminal to inform the terminal of a multimedia message addressed to the terminal that has arrived at the multimedia messaging centre, wherein the method comprises:

transmitting a first message wirelessly from the terminal to the multimedia messaging centre, the first message requesting the multimedia messaging centre to transmit a notification message to the terminal for multimedia messages addressed to the terminal, that have arrived at the multimedia messaging centre and for which the terminal has not received a notification message yet, wherein said first message comprises an option to define a selection criterion so as to limit information to be sent in response to said first message.

Claims App., Br. 20. Claim 8 reads:

8. A multimedia messaging centre for transferring a multimedia message in a system, which comprises a terminal and a multimedia messaging centre, which are arranged to communicate with each other at least partially wirelessly, the multimedia messaging centre being arranged to receive multimedia messages, addressed to the terminal, and to transmit a notification message to the terminal to inform the terminal of a multimedia message addressed to the terminal which has arrived at the multimedia messaging centre, wherein the multimedia message center comprises:

means for receiving a first message transmitted by the terminal, the first message requesting the multimedia messaging

centre to transmit a notification message to the terminal for multimedia messages addressed to the terminal that have arrived at the multimedia messaging centre and for which the terminal has not received a notification message yet; and

means for determining whether there are multimedia messages, addressed to the terminal, at the multimedia messaging centre for which the terminal has not received a notification message yet.

Claims App., Br. 22-23.

C. *The references and rejections*

The Examiner relies on the following references:

3rd Generation Partnership Project; Technical Specification Group Terminals; Multimedia Messaging Service (MMS); Functional description; Stage 2 (3G TS 23.140 version 1.0.0) ("3GPP").

Zahariev	US 6,035,104	Mar. 7, 2000
Short et al. ("Short")	US 6,130,892	Oct. 10, 2000
Skladman et al. ("Skladman")	US 6,400,810 B1	Jun. 04, 2002

The claims are rejected on the following grounds.

1. Claims 1, 3-5, 7-10, 12, 14, 15, and 17 stand rejected under 35 U.S.C. § 103(a) over 3GPP in view of Zahariev. Answer 4, 9.

2. Claims 2, 11, 13, and 16 stand rejected under § 103(a) over 3GPP in view of Zahariev and Skladman. *Id.* at 7.

3. Claim 6 stand rejected under § 103(a) over 3GPP in view of Zahariev and Short. *Id.* at 10.

Appellants argue the merits of only the independent claims and dependent claim 7.

THE ISSUES

Appellants have the burden to show reversible error by the Examiner in maintaining the rejection. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The specific issues are identified below.

DOES THE 3GPP QUERY SATISFY THE REQUIREMENTS OF THE CLAIMED "DEFINED QUERY"?

Appellants (e.g., Br. 9) use the term "defined query" as shorthand for the requirement that the first message "request[] the multimedia messaging centre to transmit a notification message to the terminal for multimedia messages addressed to the terminal, that have arrived at the multimedia messaging centre and for which the terminal has not received a notification message yet," as recited in each of the independent claims.[3]

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[3] At page 11 of the Answer, the Examiner incorrectly reads
(Continued on next page.)

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The 3GPP reference is a 3GPP Technical Specification defining stages 2 and 3 of the non-realtime Multimedia Messaging Service (MMS). 3GPP at 5.

As explained below, the 3GPP reference describes having the terminal send a first message (i.e., query) requesting notification of undelivered multimedia messages. The issue therefore is whether the 3GPP query satisfies the requirements of the defined query.

Figure 11 of SGPP, on which the Examiner relies, is reproduced below.
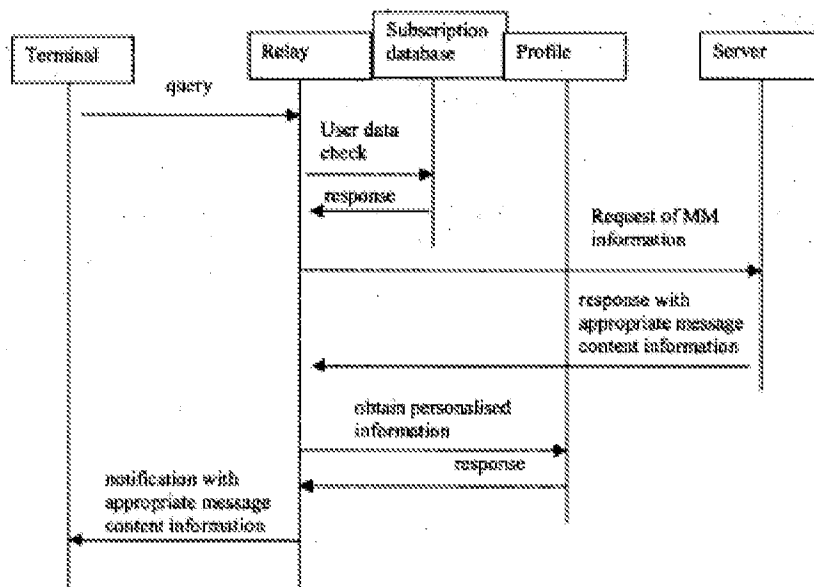

Figure 11: Query MM Information

Appellants' "defined query" term on the recited "option to define a selection criterion so as to limit information to be sent in response to said first
(Continued on next page.)

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Figure 11 depicts an example of "terminal originated flow" in the
Multimedia Messaging System (MMS). *Id.* at 19. Relying on Figure 11,
3GPP explains:

> The terminal sends a query to the Relay about messages (and
> message contents) stored in the server. Then the Relay makes a
> user data check from the Subscription database if required
> (subject to prior MM session establishment). The purpose of
> this action is to ensure that the user has the right to perform this
> operation.
>
> The Relay sends a request of MM information to the server.
> Server responses [*sic*] with message information. This response
> could contain e.g. the information about the number of
> messages stored in the server and information what kind of
> message elements stored messages contains. Then Relay
> obtains the personalised information of the recipient from the
> Profile. Finally the Relay sends to the terminal notification
> with message information.

Id at 20. Although the aforementioned "Profile" is not relied on by the
Examiner or Appellants, we note that the personalized information stored in
the profile can include instructions concerning how to handle multimedia
messages. That is, in describing Figure 17, 3GPP explains that the "MM is
processed according to the profile information at the Server, e.g. MM or
MM elements are deleted, forwarded to another server or stored for later
retrieval using pull delivery." 3GPP at 23. As shown in Figure 15 and

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message," which limitation Appellants argue separately.

described at page 22, the stored profile settings can be altered in response to
a profile management command issued by the terminal.

Section 8.3.3 of 3GPP, cited by Appellants, explains that

[t]he MMS query operation is used to retrieve information of
the existing multimedia messages in the MMS relay. The query
operation retrieves all the multimedia message notifications
from the MMS relay and then allows the user to retrieve the
messages.

The MMS query operation uses GET method over connection-
oriented WAP session. In the reply, there are one or more
multimedia message notifications.

Id. at 17.

After receiving the notification message, the user, as shown in
Figure 12 (*id.* at 19) and described at page 20, can "request[] a delivery of a
specific MM from the relay. The whole MM or parts of it could be
requested." *Id.* The MM is sent to the terminal, which then acknowledges
the delivery. *Id.*

Appellants argue that "[t]he generalised query disclosed in 3GPP
results in all notifications being sent whether received by the terminal or not
(See section 8.3.3, Line 2)" and that "[t]here is no disclosure or suggestion
in 3GPP of differentiating between notifications the terminal has already
received and those it has not received as called for in the defined query of
claim 1." Br. 9. We understand Appellants' position to be that the

"defined query" of claim 1 should be interpreted as a request for notification of *all* multimedia messages addressed to the terminal that have arrived at the multimedia messaging center and for which the terminal has not received a notification message yet, including (1) multimedia messages as to which the MMSC has not yet sent notification messages and (2) multimedia messages as to which the MMSC has sent notification messages that have not been acknowledged by the terminal. Specification at 7:9-12 and 8:3-5. However, the "defined query" does not require notification of both of these types of multimedia messages and therefore is broad enough to read on notification of either type of message. Appellants do not deny that the query in 3GPP will result in notification of multimedia messages that have arrived at the multimedia messaging center but as to which the MMSC has not yet sent notification messages. Furthermore, as explained *infra* in the discussion of claim 7, 3GPP also appears to resend notifications that were sent but were not acknowledged by the terminal.

For the foregoing reasons, Appellants have not shown that the Examiner erred in finding that 3GPP satisfies the "defined query" limitation, which is recited in all of the independent claims. However, Appellants also argue other limitations in the independent claims, which are addressed *infra*.

DOES 3GPP DISCLOSE THE "MEANS FOR DETERMINING" RECITED IN INDEPENDENT CLAIMS 8 AND 15?

Appellants have properly grouped claims 8 and 15 together with claims 1, 9, 10, and 17 insofar as the "defined query" limitation is concerned. However, as explained below, that grouping is incorrect insofar as the other argued claim limitations are concerned.

Although claim 8 stands rejected over 3GPP in view of Zahariev, the Examiner does not actually rely on Zahariev with respect to this claim. The first paragraph of claim 8 recites the "defined query" discussed above. The Examiner reads the second paragraph of claim 8 (i.e., "means for determining whether there are multimedia messages, addressed to the terminal, at the multimedia messaging centre for which the terminal has not received a notification message yet") on 3GPP's Figure 17 and the first two paragraphs at page 23. Final Action 6; Answer 7. Appellants have not even addressed this position of the Examiner, let alone shown that it is erroneous. Instead, Appellants argue (Br. 13) that claim 8 is patentable over the prior art for the reasons given with respect to claim 1. However, claim 1 does not recite a limitation that corresponds to the "means for determining" recited in claim 8. Nor does claim 8 recite a limitation that corresponds to the "option to define a selection criterion" limitation recited in claim 1 (addressed *infra*).

Because Appellants have failed to show that the Examiner erred in finding that 3GPP discloses the "defined query" or the "means for determining" recited in claim 8, we are affirming the rejection of claim 8 as

well as the rejections of its dependent claims 12 and 13, which are not separately argued. *In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

For the same reasons, we are affirming the rejection of independent claim 15 and its dependent claim 16. Claim 15 recites a "computer program product" including "computer readable program code means" for causing the multimedia messaging center to perform the same functions that are recited in the "means plus function" limitations of claim 8. Appellants do not separately argue the "computer program product" or "computer readable program code means" language.

DO 3GPP AND ZAHARIEV SUGGEST THE "DEFINE A SELECTION CRITERION" LIMITATION RECITED IN INDEPENDENT CLAIMS 1, 9, 10, AND 17?

Independent claims 1, 9, and 10, in addition to the above-discussed "defined query," specify that the "first message comprises an option to define a selection criterion so as to limit information to be sent in response to said first message." Claim 17 similarly recites "means for causing the terminal to define a selection criterion in said first message to limit information to be sent in response to said first message."[4] The Examiner

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[4] In their "Summary of Claimed Subject Matter" (Br. 2), Appellants read the "option to define a selection criterion" limitation on their above-quoted disclosure of including in the request a header specifying a date and time. Specification 11:33 to 12:3.

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found that 3GPP fails to disclose this feature and relies on Zahariev for a suggestion of modifying 3GPP's request to include this feature. Answer 4-5, 9.

Zahariev discloses a system for receiving and forwarding email messages for a subscriber. Zahariev, col. 1, ll. 47-50.

In the "Background of the Invention," Zahariev explains that there is a need for

> a smart filter system that operates firstly to decide, based upon certain criteria set up by the user, if, when e-mail is received, the user is to be notified by pager or similar services, and secondly if and where to forward mail. Such an enhancement in e-mail services allows the user to avoid being disturbed by unimportant messages, as well as to avoid high costs of unsolicited and or unwanted mail reception on expensive wireless systems or other remote systems.

Id., col. 1, ll. 35-44. Zahariev's invention operates as follows:

> [W]hen e-mail is received, a copy is typically forwarded to the customer's normal base address. A copy is also retained on the server, which is then analyzed by the MailFilter code routine on line 110. A match of pre-programmed criteria with mail message characteristics generates an Alert, which on Line 111 is used to generate a page to a paging unit carried by the subscriber. Additionally, each page is complemented with a unique ID stamp for identification. In line 113 and 114 the subscriber can request either a fax back or a forwarding of the specific message by phone using the id stamp from line 112.

Id., col. 2, l. 60 to col. 3, l. 3.

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More particularly, "[i]n line 133, a Filter Mail procedure filters new incoming mail, then looks up the customer for whom it was received in the customer database, gets stored customer records including pre-stored e-mail filtering criteria, and checks for a match, storing relevant results in the alert table." *Id.*, col. 3, ll. 20-24.

The Examiner (Answer 5, 19) specifically relies on Zahariev's following discussion of filtering:

> The here-presented system provides an ability to selectively filter information based on e-mail, and to notify a subscriber of availability of such selected information, giving the subscriber an option to have the message forwarded either by e-mail or fax to a specific location. For example, if a subscriber expects a document as an attachment by e-mail, but is only interested in comments contained in the copy (body) of the message, he may setup a filter as following: Filter1:Sender=XYZ:Subject=ABC:Attachment= Yes;. This Filter would tell the filter software to look for matches in this subscriber's incoming mail. Once a message is received that matches the criteria, the subscriber will receive a page that could look like:MsgID=1234, Filter1. The subscriber then can call the Auto Attendant and identify himself with Customer ID and password, upon which he will be prompted to enter the message ID. Next he can select means of delivery, like e-mail or fax, and then enter numbers or addresses, or select one of a limited set of preprogrammed numbers or addresses.

Id., col. 3, l. 64 to col. 4, l. 14.

Citing the above passage, the Examiner explained that

[the] motivation to combine Zahariev with 3GPP is to allow the user to selectively filter information and to notify the user of

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availability of such selected information. The user can select
the means of delivery for the message (see line 63 of column 3
through line 14 of column 4 in Zahariev).

Answer 19. The Examiner also stated that "the ability to selectively filter
information is functionally equivalent to defining a selection criterion so as
to limit information to be sent in response to the first message." *Id*. at 13.
We therefore understand the Examiner (1) to be relying on Zahariev's
teaching of allowing the user to identify the types of email information that
will result in issuing an alert (i.e., notification) to the pager and (2) to have
concluded that this teaching would have made it obvious to modify 3GPP's
query so as to permit it to limit the multimedia messages for which
notification is requested.

Appellants argue that the rejection is improper because 3GPP and
Zahariev are not analogous prior art and also because the Examiner has
failed to establish a reasonable rationale for combining the reference
teachings in a manner that satisfies the claims.

A. *Whether 3GPP and Zahariev are analogous prior art*
      (1) Principles of law
      "[T]he examiner bears the initial burden, on review of the prior art or
on any other ground, of presenting a *prima facie* case of unpatentability." *In
re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). A rejection under
35 U.S.C. § 103(a) must be based on the following factual determinations:
(1) the scope and content of the prior art; (2) the level of ordinary skill in the

art; (3) the differences between the claimed invention and the prior art; and (4) any objective indicia of non-obviousness. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)).

"A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). The "problem" used in determining whether prior art is analogous is not limited to the problem the applicant was trying to solve. The reason is that "any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *In re ICON Health and Fitness Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 2007) (quoting *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007)).

(2) Analysis

In finding that Zahariev and 3GPP are both in the same "field of endeavor," the Examiner has described the field of endeavor of 3GPP as "multimedia messaging system in general" (Answer 20) and has also characterized Zahariev's email system as a "multimedia messaging system" on the ground that "email is in fact multimedia because it may contain text, graphics, video, or attachment files of virtually any type" (Advisory Action

2), a characterization that is contested by Appellants. Reply Br. 3. We need not decide whether this characterization of Zahariev is correct or even whether the 3GPP and Zahariev are in the same field of endeavor, because we find that Zahariev constitutes analogous art when applying the second inquiry of the test for analogous art. In that inquiry, the question is whether a person skilled in the art would have considered Zahariev relevant to solving any problem with the 3GPP system. Appellants' arguments to the contrary notwithstanding, we find that Zahariev would have been considered relevant to 3GPP and thus is analogous prior art because both are directed to transmitting a wireless notification message to a terminal to identify any messages that have been received by a server and are addressed to that terminal.

B. *Whether the Examiner has provided a reasonable rationale for combining the reference teachings in the proposed manner*

(1) Principles of law

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1739). Discussing the obviousness of claimed combinations of elements of prior art, *KSR* explains:

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of

> ordinary skill can implement a predictable variation, §103
> likely bars its patentability. For the same reason, if a technique
> has been used to improve one device, and a person of ordinary
> skill in the art would recognize that it would improve similar
> devices in the same way, using the technique is obvious unless
> its actual application is beyond his or her skill. *Sakraida* [*v. AG
> Pro, Inc.,* 425 U.S. 273 (1976)] and *Anderson's-Black Rock*[,
> *Inc. v. Pavement Salvage Co.,* 396 U.S. 57 (1969)] are
> illustrative—a court must ask whether the improvement is more
> than the predictable use of prior art elements according to their
> established functions.

KSR, 127 S. Ct. at 1740. If the claimed subject matter "involve[s] more than

the simple substitution of one known element for another or the mere

application of a known technique to a piece of prior art ready for the

improvement," *id.,*

> it will be necessary . . . to look to interrelated teachings of
> multiple patents; the effects of demands known to the design
> community or present in the marketplace; and the background
> knowledge possessed by a person having ordinary skill in the
> art, all in order to determine whether there was an apparent
> reason to combine the known elements in the fashion claimed
> by the patent at issue.

Id. at 1740-41. "To facilitate review, this analysis should be made explicit."

Id. at 1741. That is, "there must be some articulated reasoning with some

rational underpinning to support the legal conclusion of obviousness." *Id.*

(quoting *Kahn*, 441 F.3d at 988. *See also PharmaStem Therapeutics Inc. v.*

ViaCell Inc., 491 F.3d 1342, 1360 (Fed. Cir. 2007) (proponent of

obviousness based on combination of references must show "that a person of

ordinary skill in the art would have had reason to attempt to make the composition or device, or carry out the claimed process, and would have had a reasonable expectation of success in doing so.") (citations omitted).

The rationale for combining reference teachings is not limited to the problem the applicant was trying to solve: "[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *In re ICON Health and Fitness Inc.*, 496 F.3d at 1380 (quoting *KSR*, 127 S. Ct. at 1742).

Also, a rationale for combining or modifying reference teachings can be based on common knowledge or common sense rather coming from the references themselves. "[T]he [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 127 S. Ct. at 1741.

Furthermore, a reference may be understood by the artisan to be suggesting a solution to a problem that the reference does not discuss. *See KSR*, 127 S. Ct. at 1742 ("The second error of the Court of Appeals lay in its assumption that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem. . . . Common sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together

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like pieces of a puzzle. . . . A person of ordinary skill is also a person of ordinary creativity, not an automaton.").

    (2) <u>Analysis</u>

    Appellants concede that Zahariev's "alert" that is sent to the pager is a "notification message" (Reply Br. 6) but challenge the Examiner's proposed modification of the 3GPP query (the recited "first message") on several grounds. Appellants argue, *inter alia*:

> In Zahariev, no notification is requested by means of a "first message." . . .

> On page 17 the Examiner alleges that Col. 3, line 64 through Col. 4, line 14 of Zahariev would teach a selection criterion which would limit information to be sent in response to the first message. However, claim 1 further requires that the selection criterion be such that it would <u>limit information to be sent in response to the first message</u>. This section of Zahariev does not disclose or suggest this feature claimed by Applicant since there is no teaching of a first message. . . . Since Zahariev does not present the first message as is recited in Applicant's claims, Zahariev cannot present an option to define a selection criterion in a non-existing first message.

Reply Br. 6. We agree with Appellants that in Zahariev the user's selection criteria are not transmitted to the email server as part of a first message requesting notification of emails that are addressed to the user. Instead, the user's selection criteria are prestored in the email server prior to the server's issuance of an alert (i.e., notification) to the pager. Zahariev, col. 3, ll. 20-24. We note that this prestorage of filtering criteria in Zahariev is similar to

3GPP's storage of a user's preferences in the user's profile in the relay,
preferences the user can alter by sending a profile management command to
the relay, as depicted in Figure 15 of 3GPP. However, although 3GPP does
not state that a profile management command (Fig. 15) can be combined
with a query requesting a notification (Fig. 11), we conclude that it would
have been obvious to combine a profile management command with a query
in order to reduce the number of separate transmissions from the terminal to
the relay, in which case the recited "first message" reads on the combined
profile management command and query for a notification.

For the foregoing reasons and because 3GPP discloses the claimed
"defined query," we are affirming the rejection of independent claims 1, 9,
10, and 17 as well as the rejections of unargued dependent claims 2-6, 11,
and 14.

DO 3GPP AND ZAHARIEV DISCLOSE OR SUGGEST THE
INVESTIGATING STEP RECITED IN CLAIM 7?

Claim 7, which is separately argued and depends on claim 1 through
claim 3, reads:

> 7. A method according to claim 3, wherein it is
> determined, at the multimedia messaging centre, whether the
> multimedia messaging centre has multimedia messages,
> addressed to the terminal, for which the terminal has not
> received a notification message, by investigating whether the
> multimedia messaging centre has received an acknowledgement
> to the notification message from the terminal.

The Examiner (Answer 21) reads this limitation on Figure 12 of 3GPP, which depicts the actions taken by the relay and server in response to a user request for delivery of one or more of the multimedia messages identified in the notification message, and more particularly on the associated explanation that "the MM is sent to the terminal and the terminal acknowledge[s] the delivery." 3GPP at 20. Appellants argue that "[t]here is simply no disclosure in Figure 12 or the corresponding caption of determining if the multimedia messaging centre has multimedia messages for which the terminal has not received notification by <u>investigating</u> whether the multimedia messaging centre has received an acknowledgement to the notification message from the terminal," as required by claim 7. Br. 14.

This argument is not responsive to what we understand to be the Examiner's position, which is that because the relay receives acknowledgements from the terminal identifying multimedia messages that have been received by the terminal, those messages will not be the subject of future notification messages. As further support for the Examiner's position, we note that 3GPP discloses a "MMS delivery report," which "is a report to the sender of the multimedia message indicating the status of the delivery to the recipient. Typical status indications could be: received, rejected, expired, etc." 3GPP at 17, para. 8.3.5. These status indications suggest that the server keeps track of (i.e., "investigates") which multimedia messages have been acknowledged by the terminal.

The rejection of claim 7 is therefore affirmed.

DECISION

The rejection of claims 1, 3-5, 7-10, 12, 14, 15, and 17 under 35 U.S.C. § 103(a) for obviousness over 3GPP in view of Zahariev is affirmed.

The rejection of claims 2, 11, 13, and 16 under § 103(a) for obviousness over 3GPP in view of Zahariev and Skladman is affirmed.

The rejection of claim 6 under § 103(a) for obviousness over 3GPP in view of Zahariev and Short is affirmed.

The Examiner's decision that claims 1-17 are unpatentable over the prior art is therefore affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. §§ 41.50(f) and 41.52(b).

AFFIRMED

rwk

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